

DOCKET NO.: IVPH-0049
Application No.: 09/863,301
Office Action Dated: August 24, 2005

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Larry Hamid, et al.

Application No.: **09/863,301**

Filing Date: **May 24, 2001**

For: **Method and System for Providing Gated Access for a Third Party to a Secure Entity or Service**

Confirmation No.: **1343**

Group Art Unit: **2135**

Examiner: **Thanhnga B. Truong**

**EXPRESS MAIL LABEL NO: EV765635625US
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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

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Withdrawal of the Final Rejection is believed appropriate for the following reasons:

1. Applicant respectfully submits that the rejection of claim 1 as being anticipated by Li et al. (US 6,219,793) is improper because Li et al. do not teach or suggest "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed.

Li et al. disclose a system in which a mobile telephone 102 includes a fingerprint scanner and an authenticated fingerprint from the user is required to authorize a wireless communication. In this fashion, only calls from authorized users are connected. In contrast, claim 1 relates to a method by which a first designated user provides gated access for *a third party* to a secure entity or service. In other words, a first designated user authorizes gated access by a different person to the secure entity or service for a limited period of time. This is accomplished by providing the claimed "wireless gating signal." For example, as set forth in paragraph [0045] on page 15 of the specification, a stockbroker may use the claimed method to provide access to a computer network for his staff only during his presence. By contrast, Li et al.'s system is designed to enable access to the wireless network by the person who provides his or her fingerprint at the fingerprint scanner on the mobile phone. Li et al. do not discuss third party access to a secure entity or service by providing the claimed "wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service" where the access is "provided for a predetermined, limited period of time" as claimed.

The Examiner responded to Applicant's argument by alleging that the term "wireless gating signal" is "just another term to activate and/or turn on/off [sic] signal through wireless communication" and that Li et al. thus teach the claimed subject matter. However, accepting the Examiner's interpretation for the sake of argument, Li et al. still do not disclose turning on/off the access of a third party as claimed. The closest Li et al. come to this is an embodiment at column 15, lines 15-30, whereby multiple users may use the same wireless phone by storing challenge keys 202 for each user in the challenge key database at the mobile switching center. The phone owner may function as a "master user" who may allow other users to use his or her phone by activating appropriate buttons on the phone and associating

the user's fingerprint with the master user's challenge key stored in the database at the mobile switching center. In other words, the master user can remotely authorize the use of his or her mobile phone by validating the use with his or her fingerprint. The second user would then use the wireless phone by swiping his or her fingerprint and proceeding to make a call once access is granted. Applicant submits that such teachings by Li et al. also fall well short of anticipating claim 1.

In particular, while Li et al. allow a first user to authorize secure access to a wireless network by a second user, no "wireless gating signal" (or even on/off access as interpreted by the Examiner) is provided as set forth in claim 1. In fact, no access at all is provided until the second user is granted access upon fingerprint authentication and such access is not "gated" by the first user in that it may continue indefinitely. The access control is provided by "activating appropriate buttons" at the wireless phone - not by sending a wireless gating signal "enabling wireless signals provided by the third party to access the secure entity or service ... for a predetermined, limited period of time" as claimed. In Li et al., once enabled, the access by the second party would be unlimited and not "wirelessly gated" as claimed. Withdrawal of the rejection of claim 1 as anticipated by Li et al. is thus appropriate and is respectfully solicited.

2. Claims 2-20 stand finally rejected). Applicant respectfully submits that the rejection of claims 2-20 as allegedly being obvious over Li et al. in view of Diamant et al. (US 5,969,632) is improper because Li et al. and Diamant et al. together do not teach or suggest "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed and hence do not support a *prima facie* case of obviousness.

As noted above, Li et al. do not teach "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed in each of the independent claims 1, 4, 11 and 15. Diamant et al. provide no such teachings either. On the contrary, Diamant et al. disclose a communication apparatus in which security flags may be set to on and off (Figure 8, steps 500 and 506). Applicant can find no teachings in Diamant et al. that

teach or suggest the missing step of Li et al., namely, "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time." In the absence of such teachings, even if one skilled in the art would have been motivated to combine the teachings of Li et al. and Diamant et al. as the Examiner proposes, the claimed invention could not have resulted.

Given that Li et al. and Diamant et al., taken separately or together do not teach or suggest all the claim limitations, the Examiner has not established a *prima facie* case of obviousness. Moreover, the Examiner has further failed to provide a *prima facie* case of obviousness with respect to any claim since the Examiner has not met his burden of providing a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. Instead, the Examiner has provided general references to preventing "hostile intrusion by unauthorized persons or data viruses" by combining the teachings of Li et al. and Diamant et al. However, the Examiner has provided no plausible reason as to why one skilled in the art would use the security flags of Diamant et al. in a system of the type disclosed by Li et al. Applicant suggests that no such motivation exists because security flags would serve no apparent purpose in the Li et al. system where the access by a third party is not gated as claimed and need not be "flagged" as claimed. As a result, one skilled in the art would not be motivated to combine the teachings of Li et al. and Diamant et al. to provide a "wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed.

In the absence of the requisite teachings and motivations to combine teachings to establish *prima facie* obviousness, the rejection of claims 2-20 as being obvious over Li et al. and Diamant et al. is improper and withdrawal of the obviousness rejection is respectfully solicited.

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Conclusion

In view of the above, Applicant submits that claims 1-20 are allowable over the art of record. Allowance of claims 1-20 is solicited.

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